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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/690,773	10/17/2000	Geoffrey B. Rhoads	60310	3646
23735	7590	10/05/2004	EXAMINER	
DIGIMARC CORPORATION 9405 SW GEMINI DRIVE BEAVERTON, OR 97008			HAILU, TADESSE	
			ART UNIT	PAPER NUMBER
			2173	

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/690,773

Applicant(s)

RHOADS ET AL.

Examiner

Tadesse Hailu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 17-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5,8,9,14 and 17-23 is/are allowed.
- 6) ☐ Claim(s) 1-4,6,7,10-13 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/13/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is in response to the patent application number (09/690,773) filed on 10/17/2000.
2. The instant application claims priority from US Application number 08/508,083, filed July 27, 1995 (now US Pat No 5,841,978).
3. The Information Disclosure Statement submitted on May 13, 2004 is considered and entered into the file.
4. The pending claims 1-15, 17-23 are examined herein as follows.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before

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November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1, 6, 10, 11, and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Benade et al (US Pat No 5,621,864).

With regard to claim 1:

Benade discloses a system (label generation systems) for enabling a user to associate a machine behavior (e.g., printing and labeling) with a physical object (e.g. label, Figs. 4 through 8).

Benade discloses a registration system (column 6, lines 15-25, 49-65) enabling a user to specify a machine behavior (e.g. printing) to be associated with a physical object (e.g. printing on the physical object or label) via an object identifier (e.g. indicia, wherein each label in a series of labels includes unique indicia that individually identify each label according to any predefined sequence. See Abstract). Furthermore, The indicia (e.g. bar code) can be read by a machine for pricing or object identification purposes (column 9, lines 21-29).

Benade also discloses a database management system (column 16, lines 6-20, Fig. 13) in communication with the

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registration system for receiving and maintain records associating object identifiers with machine behaviors (e.g. printing) wherein the database management system is operable to receive object identifier (see Fig. 13) and in response, to initiate the machine behaviors associated with the object (column 9, lines 10-21, column 11, lines 19-31).

With regard to claim 6:

Benade also discloses a user interface (Fig. 1, 114) that enables a user to view an image of an object along with an image of a behavior to be associated with the object (e.g., labeling or printing), the user interface (114) including a control (Fig. 15) that enables the user to associate the object (e.g. rectangular label) with the behavior (printing on the label), and the user interface being operable to communicate a database structure (Fig.13) to the database management system specifying an object for the object and a description of the behavior (printing on the label).

With regard to claim 10:

Independent claim 10 corresponds generally to independent claim 1 and recites similar features in method form, and therefore is rejected under the same rationale.

With regard to claim 11:

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Benade discloses the specification of the object (e.g., label) includes a registration id provided on the object (see Figs. 4 through 8).

With regard to claim 15:

Independent claim 15 corresponds generally to independent claim 1 and recites similar features in storage form, and therefore is rejected under the same rationale.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 2, 3, 4, 7, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benade et al (US Pat No 5,621,864) in view of Houser et al (US Pat No 5,606,609).

With regard to claim 2:

Claim 2 requires a network interface to associate behaviors with the object identifiers from remote client computers. The system of Benade does not show a network interface. Houser

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discloses a computer networks that are used for an electronic document verification system (column 1, lines 24-32).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate the network interface of Houser to the system of Benade because the Benade will be able to link to outside network to exchange data (Houser, column 1, lines 24-32).

Therefore, it would have been obvious to combine Houser and Benade to obtain the invention as specified in claim 2.

With regard to claims 7 and 12:

Claim 7 requires the object identifier is embedded into the object using a watermark. Benade fails to suggest watermarking. However, Houser discloses embedding object (e.g. security object) identifier into the object using a watermark (Abstract, column 3, lines 50-60).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate the object embedding mechanism using a watermark of Houser with label encoding of Benade.

The suggestion/motivation for doing so would have to provide a very high degree of security of security and useful for managing sensitive documents (Houser, column 2, lines 29-39).

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Therefore, it would have been obvious to combine Houser and Benade to obtain the invention as specified in claims 7 and 12.

With regard to claim 3:

As applied in claim 1 above, Benade discloses the limitations of claim 3 except for "the object identifiers comprises watermark identifiers which are embedded in watermarks on corresponding objects by altering signals that are to form part of the objects to embed the object identifiers in the signals in a machine readable form." However, Houser discloses the watermark identifiers embedded in watermarks as describe in the claim (column 7, lines 66-column 8, lines 19).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate the object embedding mechanism using a watermark of Houser with label encoding of Benade.

The suggestion/motivation for doing so would have to provide a very high degree of security of security and useful for managing sensitive documents (Houser, column 2, lines 29-39)

Therefore, it would have been obvious to combine Houser and Benade to obtain the invention as specified in claim 3.

With regard to claim 4:

Benade in view of Houser discloses a watermarked label (plastic object) (column 13, lines 65-column 14, lines 32).

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With regard to claim 13:

Benade in view of Houser discloses a graphical user interface (Houser, Figs. 3A-H, 9A-C, etc) is launched in response to extracting the watermark on the object (Houser, column 4, lines 47-60, column 5, lines 3-12).

Response to Arguments

7. Applicant's arguments with respect to claims 1-4, 6-7, 10-13, and 15 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

8. Claims 5, 8, 9, 14, and 17-23 are allowed.

CONCLUSION

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Tadesse Hailu, whose telephone number is (571) 273-4051. The Examiner can normally be reached on M-F from 10:00 - 630 ET. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, John Cabeca, can be reached at (571) 273-4048 Art Unit 2173.


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10. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Tadesse Hailu

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9/30/04


RAYMOND J. BAYERL
PRIMARY EXAMINER
ART UNIT 2173